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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,456	08/26/2003	Donald E. Godshaw	04286.00124	5091

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EXAMINER

LARSON, JUSTIN MATTHEW

ART UNIT PAPER NUMBER

3782

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/648,456	GODSHAW ET AL.	
	Examiner	Art Unit	
	Justin M. Larson	3782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 9-12 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-8, 13, 14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5-8, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 6,305,587 B1) in view of Kepper (US 2,729,257 A).

Regarding claims 1 and 5, Miller discloses a foldable luggage bag (Figure 9) comprising, in combination: a first lesser capacity partial bag made from a flexible material (col. 5 lines 52-55) and including an outside surface with a front panel (22) and a periphery opposite said front panel with a first closed loop peripheral fastening mechanism (zipper 102) extending around the periphery, a side panel (28) between the front panel and the periphery defining a first bag interior; and a second flexible partial bag made from a flexible material and of greater capacity than the first, said second bag attached to the first bag and extending from the periphery of the first bag with the first peripheral fastening mechanism maintained on the first bag outside surface to enable forming a bag enclosure comprised of the volume of the first bag and a portion of the second bag, said second bag further including a second closed loop fastening mechanism (102) on the second bag outside surface, said second fastening mechanism encircling said portion of said second bag and having the same length as the first fastening mechanism and also fully attachable along its length to the first fastening.

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mechanism, said second fastening closed loop mechanism subtending the front panel of the first partial bag upon the unfolding of said first and second bags whereby the first fastening mechanism and the second fastening mechanism may be connected along their entire closed loop length to enclose the second bag within a volume comprised of the first bag and said part of the second bag encircled by the second fastening mechanism, said first partial bag having less capacity than the second partial bag.

Miller fails to disclose there being an opening in the first partial bag lying opposite the front panel of the first partial bag, wherein the opening provides access from the second partial bag into the first partial bag and vice versa such that when the second partial bag is collapsed into its storage position, it can be partially stored within the first partial bag due to the opening between the two. Instead, Miller discloses a dividing panel (72) separating the volumes of each bag that inherently prevents a user from accessing both partial bags through either of the access openings (100, 132).

Regarding the opening, Kepper teaches that when a convertible bag comprises a second bag (6) being pulled from a first bag (1), the panel separating the respective volumes of the first and second bags may be detachable, allowing a user to access both of the bags' interiors through a single opening. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the luggage bag of Miller by making wall (72) detachable, as taught by Kepper, in order to allow a user to store larger objects, objects that would otherwise be too large to store within the volume of a single bag, in a combination of the both of the bags' volumes, increasing the utility of the luggage bag.

Regarding the second partial bag being partially stored within the first bag, the detachable wall implemented on the Miller bag device would allow the second bag to be partially stored within the first partial bag, effectively satisfying this limitation in the claims.

Regarding claim 6, the second partial bag of the modified Miller bag comprises an enclosed bag with a bottom panel, a front panel including the first partial bag, a back panel spaced from the front panel, a connecting top and side panel (126) joined to the bottom panel, back panel, and the front panel, and at least one back strap (120) attached to the back panel.

Regarding claims 7 and 8, the modified Miller bag includes first and second spaced adjustable back straps (120) attached to the back panel.

Regarding claims 9 and 10, the modified Miller bag includes an access mechanism (zipper 100) in the first partial bag.

Regarding claim 14, the first partial bag of the modified Miller bag device is positioned intermediate the top and bottom of the second partial bag.

Regarding claim 16, the modified Miller bag device includes the claimed features except for the particular size relationship between the first and second partial bags. The first bag of Miller appears to be more than 25% of the volume of the second bag. It would, however, have been an obvious matter of design choice to make the first bag smaller, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). To make the first bag

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of the modified Miller bag device smaller would not take away from the original function of the modified Miller bag device.

3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Kepper as applied above, and further in view of Bendersky (US 5,255,834 A).

The modified Miller luggage bag includes the claimed features except for there being a display on the outside surface of the first bag. Bendersky, however, teaches that it is old and well known in the art to provide displays on the outside of bags/packs. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an image or display on the outside of the first bag, as taught by Bendersky, in order to provide an aesthetically appealing bag/pack to suit various consumer tastes.

Response to Arguments

4. Applicant's arguments filed 11/13/06 have been fully considered but they are not persuasive.

Applicant has asserted that Miller fails to disclose a second bag that fits into a first bag; that there is no opening in the first bag into which the second bag may be fitted; and that the second, collapsed, bag has non-flexible sides. Examiner directs Applicant to the combination of Miller and Kepper, where a detachable separating panel, as taught by Kepper, is implemented in the bag of Miller. This detachable panel effectively provides an opening between the various bag portions of Miller. Because the panel is detachable, a user, if they so desired, could leave the panel detached and at least partially store the second bag portion within the first bag portion if they so desired.

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Examiner also notes that the sides of the second, collapsed, bag of Miller must be flexible or else the second bag would not be capable of being compacted or collapsed.

Applicant has asserted that Kepper does not teach the idea of placement of a second bag into a first bag. Examiner directs Applicant's attention to the fact that the bottom panel (7) of the first bag is detachable, and if detached, at least portions of the second bag could certainly be stored within the first bag.

Applicant has asserted that neither Miller nor Kepper disclose the claimed size relation between the first and second bags, where the first bag is no more than 25% of the volume of the second bag. Applicant has also asserted that this particular relationship enables the bags, when opened or expanded, to provide adequate significant storage capacity, while the combined bags will occupy very little space when appropriately combined because the second partial bag is fitted into the first partial bag. As set forth above, Examiner is of the position that a mere change in the size of the smaller bag of the modified Miller bag device would have been obvious to one having ordinary skill in the art. One of ordinary skill in the art would certainly recognize that by making the first bag smaller, the overall size of the combined bags would be smaller and easier to store. When making the first bag smaller, there would be no unexpected results of which one of ordinary skill in the art would not have been aware.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Larson whose telephone number is (571) 272-8649. The examiner can normally be reached on Monday - Thursday, 7am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JML
11/28/06


NATHAN J. NEWHOUSE
SUPERVISORY PATENT EXAMINER